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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,184	08/23/2001	Walter F. Anderson	CM04882H	1947

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EXAMINER

SCHUBERT, KEVIN R

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,184

Applicant(s)

ANDERSON ET AL.

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 12-18 have been considered. The applicant has argued that the examiner's rejections in the action mailed 6/3/05 were improper. The disagrees and maintains all rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-13 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Mulford, U.S. Patent No. 5,301,232.

As per claim 12, the applicant describes a method comprising the following steps which are met by Mulford:

a) receiving, by the key delivery device, one or more key management messages including indicia of respective target communication devices that are to receive the key management messages (Col 4, lines 17-44);

b) operably connecting the key delivery device to one or more candidate encryption devices (Col 4, lines 17-44);

c) determining, by the key delivery device upon connecting to the one or more candidate encryption devices, which ones of the candidate encryption devices are target encryption devices (Col 4, lines 45-67);

d) delivering, from the key delivery device, one or more key management messages to the candidate encryption devices determined by the key delivery device to be target encryption devices (Col 4, lines 45-67).

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As per claim 13, the applicant describes the method of claim 12, which is met by Mulford, with the following limitations which are also met by Mulford:

a) determining, by the key delivery device upon connecting to the one or more candidate encryption devices, which ones of the candidate encryption devices are not target encryption devices (Mulford: Col 4, lines 45-67);

b) not delivering key management messages to the candidate encryption devices determined by the key delivery device not to be target encryption devices (Col 4, lines 45-67).

As per claim 17, the applicant describes the method of claim 12, which is met by Mulford, with the following limitations which are also met by Mulford:

a) determining a target destination identifier associated with the encrypted key management message (Col 4, lines 17-67);

b) delivering the encrypted key management message to a target communication device corresponding to the target destination identifier (Col 4, lines 17-67).

As per claim 18, the applicant describes the method of claim 17, which is met by Mulford, with the following limitation which is also met by Mulford:

Wherein the step of receiving an encrypted key management message comprises receiving a key management message frame including a key management message field and a target destination field, the key management message field including the encrypted key management message and the target destination field including an encrypted target destination identifier, the step of determining a target destination identifier being accomplished by decrypting the encrypted target destination identifier (Col 4, lines 17-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steinbrenner, U.S. Patent No. 5,093,860, in view of Gilhousen, U.S. Patent No. 4,613,901.

As per claims 12-15 and 17, these claims are rejected for the reasons given in the office action dated 12/18/00 for application number 09/387,546.

Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulford in view of Doiron, U.S. Patent No. 5,481,610.

As per claims 14-15, the applicant discloses the method of claim 12, which is met by Mulford, with the following limitation which is met by Dorion:

Further comprising the step of displaying, by the key delivery device upon a successful delivery of a key management message to a target encryption device, a message indicative of the successful delivery of the key management message to the target encryption device (Col 8, line 62 to Col 9, line 15);

Mulford discloses all the limitations of claim 12. Mulford also discloses that the KMC knows whether a rekey transmission is successful or unsuccessful (Col 4, line 67 to Col 5, line 2). However, Mulford does not disclose that the KMC displays a message indicating whether a transmission is successful or unsuccessful to a screen.

Dorion discloses a similar rekeying system in which the key delivery device has a screen. When a key is delivered the user is able to tell if the delivery was a success. If the transfer is a success, "Good transfer" appears on the screen. If the transfer is not a success, nothing appears on the screen. If nothing appears on the screen, a message indicative of unsuccessful delivery of a key is present to the user and the user will think that something went wrong in the key transfer.

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It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Dorion with those of Mulford and display a message indicative of a successful or unsuccessful transfer because doing so allows a user to know whether the key has been transferred.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mulford in view of Press, U.S. Patent No. 5,745,572.

As per claim 16, the applicant describes the method of claim 12, which is met by Mulford, with the following limitation which is met by Mulford in view of Press:

a) decrypting the encrypted key management message, yielding an unencrypted key management message including a target destination identifier (Mulford: Col 4, lines 28-37; Press: Abstract);

b) delivering the unencrypted key management message to a target communication device corresponding to the target destination identifier (Mulford: Col 4, lines 28-37);

Mulford discloses all the limitations of claim 12. Mulford also discloses a key tag, which is a key management message and a target destination identifier that is received by the KMC and used to transmit a message, including the unencrypted key tag message, back to a candidate communication device which may be a target communication device. However, Mulford does not disclose that the key tag is encrypted and so does not meet part a since the key tag is sent in clear text (Col 3, line 67 to Col 4, line 4).

Press discloses a similar system in which the key tag is encrypted. Combining Press with Mulford would simply mean the addition of encryption to the key tag and would meet all the limitations of the claim. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Press with those of Mulford and encrypt the key tag because doing so offers more security and less vulnerability to hackers to the system.

Response to Arguments

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Applicant's arguments filed 10/3/05 with respect to the 102(b) rejection of claim 12 under Mulford have been fully considered but they are not persuasive. The applicant argues that no key delivery device is disclosed by Mulford and as such part a is not met by Mulford:

"Since no key delivery device is used or disclosed in Mulford, it follows that the Mulford system has no need for and Mulford correspondingly does not disclose a step of 'receiving, by the key delivery device, one or more key management messages including indicia of respective target communication devices that are to receive the key management messages'" (Remarks: page 1).

The examiner disagrees with the applicant's above statement. Mulford explicitly discloses that a KMC (306 of Fig 3) is a key delivery device which delivers key information out to a plurality of encryption devices (400 of Fig 3). The examiner refers the applicant to the following passage in which Mulford discloses that the KMC is a key delivery device:

"In step 130, if the unit is not reported lost or stolen, the KMC 306 transmits via communication resource 304 an encryption rekey command message to the particular unit. The rekey command message will provide the new encryption information to the communication device(s) 400... At this point, in step 136, the KMC 306 will update its database as to all units which still have not received new encryption keys and will continue to try to rekey these units by actively monitoring the communication activity in system 300 by returning to step 110" (Col 4, line 62 to Col 5, line 7).

Thus, as illustrated in the passage above and throughout the primary reference, Mulford does disclose a key delivery device. Hence, the examiner disagrees with the applicant's statement cited above that Mulford does not disclose a key delivery device and hence disagrees with the applicant's reasoning as to why Mulford does not meet the limitations of the claimed invention.

Further, the applicant argues that Mulford discloses a KMC and target communication devices, but not a KMC, an *intermediary* key delivery device, and target communication devices (Remarks: bottom of page 1). The applicant is presenting an argument which is outside the scope of the claimed invention. The applicant has merely claimed a "key delivery device", not an intermediary key delivery device as argued. Accordingly, the applicant's argument does not overcome the rejection of claim 12 because it is based on a limitation which is not present in the claims. Mulford's KMC is a key delivery device which receives key management messages from target communication devices which are to receive key management messages and meets part a of the applicant's claimed invention.

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Applicant's arguments with respect to the 103(a) rejection of claim 12 under Steinbrenner in view of Gilhousen have been fully considered but they are not persuasive. Claim 12 is substantially the same claim as that of claim 1 of applicant's previously filed application 09/387,546. In the action dated 12/18/00, the examiner (different from the current examiner) rejected the claim as being anticipated by Steinbrenner in view of Gilhousen. In response to the examiner's rejection, the applicant presented the same argument in the Remarks dated 3/7/01 (see especially pages 4 and 5) as that of the instant argument. More specifically, this argument is that Steinbrenner fails to teach the limitation that key data received in the KVL include "indicia of respective target communication devices that are to receive the key management messages" (part a) and that since there is no indicia included in the key data Steinbrenner does not disclose "determining, by the key delivery device upon connecting to the one or more candidate encryption devices, which ones of the candidate encryption devices are target encryption devices" (part c). In response to this argument, the examiner maintained the rejection and noted that the Gilhousen reference was disclosed in order to satisfy these limitations:

"What was incorporated into Steinbrenner from the Gilhousen was the feature of storing, in a key delivery device, a record identifying target encryption devices. In response to the Applicant's arguments that the list could not be used to determine whether or not an encryption device is a target encryption device, the examiner respectfully disagrees. As stated in the rejection, Gilhousen features a list that defines groups of subscribers having a common grade of service. This feature alone could determine if an encryption device is a target device (e.g., if the device is in a certain group, it is a target). For these reasons, Applicant's arguments asserting that an improper combination of references was made under section 103(a) is not persuasive and the rejection of claim 1 has been maintained" (Office Action dated 5/20/01).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER